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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/490,268 01/24/00 BOSTOCK

G 720a

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PM82/0426

EXAMINER

THISSELL, J

ART UNIT	PAPER NUMBER
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3635

DATE MAILED:

04/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/490,268

Applicant(s)

Bostock

Examiner

Examiner J. Thissell

Group Art Unit

3635



☒ Responsive to communication(s) filed on Jan 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior copending Application No. 09/235620, filed January 22, 1999. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 12 and 13, "the depth" of the groove is claimed to be greater than the length of the tongue. This is indefinite since it is not clear whether the depth of the groove is from the rear leg or the front leg, which are claimed to be different lengths.

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Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-11, 12-16, and 22-25 are provisionally rejected under the judicially created doctrine of double patenting over copending Application No. 09/235620. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: interlocking panel pieces with a groove and recess, the recess being greater than the groove; the panel pieces being attached to a support structure; the fastening means by which the panel pieces are attached to the support structure; and the method of attaching the panel pieces.

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Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dail ('640). Dail discloses a panel assembly having panel pieces 22 with front and rear sides, pairs of opposing side and edge faces, one edge being formed as an elongate projection 26, a second edge face formed as an elongate recess, and in Figure 3 a space can be seen between the end of the projection and the recess which indicates that the recess is of greater depth than the projection.

Regarding claims 2, 3, 13, and 14, the panel pieces are joined to one another and are secured to a support structure 20 which can be considered a studded frame.

Regarding claims 8, 9, and 11, the panel assembly inherently includes a top and bottom panel pieces that are located at the uppermost and lowermost locations of the assembly when

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viewing the assembly straight on. These pieces, being similar to the piece discussed above, also have grooves in them.

Regarding claim 10, Dail's indented shadow line can be seen in Figure 3 on the front face (bottom) where the two panels meet each other.

6. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Frashour et al. ('553). Frashour discloses a panel assembly with a plurality of panel pieces 10 joined together in matching engagement and secured to a support structure 20 that can be considered a studded frame. Each panel piece has a front and rear side, two opposing edge faces, one edge face with a beveled recess 56 that extends from one side of the panel piece to another, the recess is defined by a projecting first flange whose outer wall is coextensive with the rear side (side attached to 20) of the panel piece.

There exists a second edge face that also has a beveled recess that matches the first edge face, and when joined together there exists an elongate space that demarcates one piece from another (32,34,52, and space at support member).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7, 15, 16, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dail ('640). Dail discloses a panel assembly as stated above in section 5, except for the following features:

Regarding claims 4, 15, and 23, Dail does not state that the support structure is a wall of an elevator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Dail's paneling assembly in an upright vertical position on a wall, since basic panel pieces with tongue and groove interconnection is commonly used interchangeably with floors, walls, and ceilings. An elevator wall would simply be considered a design choice, since the assembly could be attached to any type of room or wall with the proper support elements.

Regarding claims 5-7, 16, and 24, Dail discloses a panel assembly as stated above in section 5, also reciting that the panels could be nailed or otherwise fastened to the support members (column 2, lines 15-16). Dail does not specifically state that a screw or adhesive could be utilized, however, these fasteners are just another form of commonly known fasteners in the art of building construction that perform the same function. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a screw or adhesive to fasten the panels to the support member.

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Regarding method claims 22-25, since all of the structural elements are disclosed and discussed in sections 5 and 7, the steps of securing panels to a support structure, and interlockingly engaging the panels pieces, which inherently forms a space extending from the ends of the sides, are considered the obvious method of creating a panel assembly.

8. Claims 17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frashour et al. ('553).

Regarding claim 17, Frashour discloses a panel assembly with a plurality of panel pieces 10 joined together in matching engagement and secured to a support structure 20. Each panel piece has a front and rear side, two opposing edge faces, one edge face with a beveled recess 56 that extends from one side of the panel piece to another, the recess is defined by a projecting first flange whose outer wall is coextensive with the rear side (side attached to 20) of the panel piece.

There exists a second edge face that also has a beveled recess that matches the first edge face, and when joined together there exists an elongate space that demarcates one piece from another (32,34,52, and space at support member).

Frashour et al. does not disclose the panel assembly in an upright position with the panels disposed atop one another, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Frashour's paneling assembly in an upright vertical position on a wall, since basic panel pieces with tongue and groove interconnection is commonly used interchangeably with floors, walls, and ceilings.

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Regarding claims 20 and 21, Frashour discloses a panel assembly with a plurality of panel pieces 10 joined together in matching engagement and secured to a support structure 20. Each panel piece has a front and rear side, two opposing edge faces, one edge face with a beveled recess 56 that extends from one side of the panel piece to another, the recess is defined by a projecting first flange whose outer wall is coextensive with the rear side (side attached to 20) of the panel piece.

There exists a second edge face that also has a beveled recess that matches the first edge face, and when joined together there exists an elongate space that demarcates one piece from another (32,34,52, and space at support member).

Frashour does not disclose that the support structure is an elevator wall, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Frashour's paneling assembly in an upright vertical position on a wall, since basic panel pieces with tongue and groove interconnection is commonly used interchangeably with floors, walls, and ceilings. An elevator wall would simply be considered a design choice, since the assembly could be attached to any type of room or wall with the proper support elements.

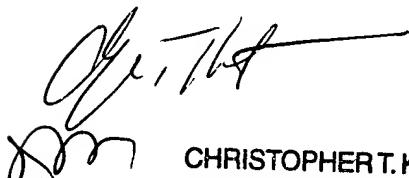
Frashour recites that the panels are secured to the support structure by a nail means, not by a screw means. However, screw fasteners are just another form of commonly known fasteners in the art of building construction that perform the same function as nails. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to interchange the fasteners and use a screw to fasten the panels to the support member.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner J. Thissell whose telephone number is (703) 306-5750.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist in Technology Center 3600 whose telephone number is (703) 308-2168.


jit
CHRISTOPHER T. KENT
PRIMARY EXAMINER

April 23, 2000